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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,927	12/02/2002	Wolfgang Bossert	A91621	6453
30008	7590	07/16/2004		
GUDRUN E. HUCKETT DRAUDT LONSSTR. 53 WUPPERTAL, 42289 GERMANY			EXAMINER HESS, BRUCE H	
			ART UNIT 1774	PAPER NUMBER

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/065,927	Applicant(s) BOSSERT	
	Examiner Bruce H Hess	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4-23-04 (election)
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 35-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/007)
Paper No(s)/Mail Date <u>2-6-03</u> | 6) <input type="checkbox"/> Other: _____ |

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1. Upon reconsideration, the election of species requirement has been withdrawn. The restriction requirement is maintained for the reasons of record. Upon the allowance of sheet material claims, a writing device employing sheet material of the same scope would be rejoined and allowed.

2. Claims 1-3 and 5-34 are rejected under 35 USC 112 (first paragraph) as being broader than the enabling disclosure as a result of applicant's failure to recite that the "embedded" particles are contained in microcapsules.

3. Claims 5 and 7-9 are rejected under 35 USC 112 (second paragraph) as being indefinite for the reasons set forth below:

A. In claim 5, the scope and meaning of "embedded between the cavities" is not clear; and

B. In claims 7-9 (see claim 7), the scope and meaning of "combined to a carbonless set" (emphasis added) is not clear.

4. Claims 1-4, 14 and 22 are rejected under 35 USC 102 (b) as being anticipated by the patent to Sakurai et al. (U.S.P. 5,006,422).

Claims 1-4, 6, 14, 22 and 24 are rejected under 35 USC 102 (b) as being anticipated by the patent to Nakano (EP 0822532).

5. Claims 15-21, 23, 24 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Sakurai et al. or Nakano.

These patents teach sheet material for receiving information which employs microencapsulated magnetizable particles. The information is writable, retrievable and changeable. Discontinuous writing areas and the ultimate form of the material (e.g., a

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brochure) constitute obvious design choices. Finally, the experimental modification of this prior art in order to ascertain optimum operating conditions (e.g., determine particle sizes) fails to render applicant's claims patentable in the absence of unexpected results.

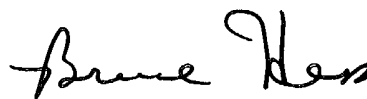
See Sakai et al. at column 1, lines 9-12 and column 4, lines 44-46. See Nakano at page 3, lines 46 and 47.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce Hess whose telephone number is (571) 272-1525. The examiner can normally be reached on Monday to Friday 9 Am to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bruce Hess/mn
6/30/2004



BRUCE H. HESS
PRIMARY EXAMINER